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09/556,062	04/20/2000	Richard R. Reisman	2222.431000A	5601
26111 7590 12/01/2009 STERNE, KESSLER, GOLDSTEIN & FOX P.L.L.C. 1100 NEW YORK AVENUE, N.W. WASHINGTON, DC 20005				
EXAMINER PEYTON, TAMMARA R				
ART UNIT		PAPER NUMBER		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

09/556,062

**Applicant(s)**

REISMAN, RICHARD R.

**Examiner**

TAMMARA R. PEYTON

**Art Unit**

2182

**Period for Reply** -- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 06 August 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 141 and 143-183 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 141 and 143-183 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/C)
- Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)
- Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

## **DETAILED ACTION**

### **Information Disclosure Statement**

1. The information disclosure statements filed September 30, 2005 fail to comply with the provisions of 37 CFR 1.52(e) and 37CFR 1.98.

At least some of the information on the CD-ROM/DVD does not fall into any of the categories listed in 37 CFR 1.52(e)(1)

The following documents may be submitted to the Office on a compact disc in compliance with this paragraph:

- (i) A computer program listing (see § 1.96);
- (ii) A "Sequence Listing" (submitted under § 1.821(c)); or
- (iii) Any individual table (see § 1.58) if the table is more than 50 pages in length, or if the total number of pages of all of the tables in an application exceeds 100 pages in length, where a table page is a page printed on paper in conformance with paragraph (b) of this section and § 1.58(c).

Many of the data files are not in ASCII format as required by 37 CFR 1.52(e)(3)(I)

Each compact disc must conform to the International Standards Organization (ISO) 9660 standard, and the contents of each compact disc must be in compliance with the American Standard Code for Information Interchange (ASCII). CD-R discs must be finalized so that they are closed to further writing to the CD-R.

Further, the conversion of a paper document to an ASCII data format for an IDS will not usually provide an accurate and complete version. Thus the requirement for a copy of the listed document is not complied with 37 CFR 1.98(a)(2) by the CD- ROM/DVD.

The CD-ROM/DVD will not be made part of the permanent record, and the information referred to therein has not been considered as to the merits.

Applicant is advised that the date of any re-submission of any item of information contained in this information disclosure statement or the submission of any missing element(s) will be the date of submission for purposes of determining compliance with the requirements based on the time of filing the statement, including all certification requirements for statements under 37 CFR 1.97(e). See MPEP § 609.05(a).

### ***Claim Rejections - 35 USC § 112***

Claims 140 rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. Examiner has reviewed the specification and cannot find support for the following claim limitations: “.. from each of a plurality of independently published portable storage media,” in claim 140. After the rigorous search no where does it clearly define the meaning of “independently published portable

storage media" as amended on 08/06/08. In response to this Office Action Applicant is required to either remove the new matter or indicate to Examiner support for this newly added claim language by specifically pointing to page(s) and line number(s) in the specification and/or drawing figure(s).

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 140, 142-151, 176-183 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicant's Admission of Prior Art (AAPA) and Filepp et al., US 5,347,632.

At the outset, Applicant is reminded that claims subject to examination will be given their broadest reasonable interpretation in light of the supporting disclosure. In re Morris, 127 F.3d 1048, 1054-55, 44 USPQ2d 1023,1027-28 (Fed. Cir. 1997). With this in mind, the discussion will focus on how the terms and relationships between the terms in the claims are met by the references.

As per claims 140, 146-149, 151, 176-179, 181, and 182, Filepp teaches a processor that executes the programmed logic to enable a user at the user station (personal computer, 405, Fig. 2), via the user interface (display, keyboard, etc), to fixed information content (application program stored on the diskettes, 428,426) from each of a plurality of portable storage media (426, 428 – application software and operating system software for initiating communication with an interactive network, 10, Fig.2, col. 4, lines 44-60) together with related remote information content (from interactive network, 10, Fig.2) from one or more remote information content sources, and wherein, for each of the plurality of portage storage media, the user interface is customized with respect to the fixed information content stored on the portable storage medium when the user access the fixed content stored on the storage medium.

Filepp teaches wherein a user station is provided with one or more floppy disk drives that hold an application software product that allows for the user to obtain access to an interactive network by means of a dial up connection. (col. 4, lines 60-col. 5, lines 1-68) Specifically, the software product offers the user the ability to access a service (i.e. news, industry, financial needs, hobbies, and cultural interests, etc., col. 6, lines 3-68, col. 7, lines ) for use by an application program installed on the user station. Filepp specifically teaches wherein the user interface is customized with respect to the fixed content stored on the portable storage medium (application software) with respective remote content from one or more remote content sources. For example, Filepp teaches wherein the user is able to receive updated stock quotes during a particular user session. Therein, one of ordinary skill would readily recognize that the user's display

screen must be refreshed regularly in order for the user to receive the ever change stock prices. (note Fig. 3, Filepp discloses the screen format and how updates related to the web page screen are obviously refreshed, col. 8, lines 64-col.22) Therefore, it would have been obvious to one of ordinary skill at the time the invention was made that the application software loaded on the user station that allows the user to initiate a connection to an interactive network is respective to remote content sources ( updated stock quote data downloaded to the user station) from the remote content source.

Filepp teaches wherein the floppy disk drives includes an application and operating system software that enable the user to initiate connections to the interactive network, it would have been obvious to one of ordinary skill at the time the invention was made that the dial up information/protocol/network address specification associated with the interactive network are also provided on the floppy disk. (Note Abstract and Specification, Figs. 1-11)

However, Applicant argues (Remarks 2-4) that Filepp is silent in respect to a plurality of independently published portable storage media. There is no argument that the two sets of diskettes 426 and 428 are indeed independently published portable storage media but rather if 426 and 428 both provide access to a remote network. Filepp teaches the two sets of diskettes including an application software (426) and operating system software (428) for initiating communication with an interactive network, 10, Fig.2, col. 4, lines 44-60). Filepp clearly states that "personal computer 405 may also include a hard-disk drive 420 for storing the application software and operating system software which may be transferred from diskettes 426 and 428

respectfully". Therein, it would have been obvious to one of ordinary skill at the time the invention was made that the combination of software application stored on diskettes 426 and 428 in effect provide the user station the ability to receive remote information content from interactive network, 10.

Further, the claim language "to fixed information content from each of a plurality of independently published portable storage media together with related remote information content from one or more remote information content sources," does not necessary required access to more than one independently published portable storage media diskette that the same time. Examiner is taking the position that only one independently published portable storage media (for example diskette 426 or 428) of Filepp can be accessed at a given moment to eventually provide access to related remote information content from one or more remote information content sources.

Nonetheless, AAPA discloses (note: Background of the Invention)

- "Electronic publication is an exploding industry in which thousands of new products including magazines and periodicals, software applications and utilities, video games, business, legal and financial information and databases, encyclopedias and dictionaries are purchased by millions of customers. Commonly, such information products are replicated in computer-readable form on magnetic or optical storage diskettes and are box-packaged with printed manuals for distribution to retail stores and direct mail sales. These marketing practices are relatively expensive and involve a significant time lag of at least days or weeks to get a product into a consumer's hands once it is created. Such costs and delays are generally acceptable for original, high value products such as collections of publications or software application, of which some examples are NEWSWEEK® Interactive CD-ROM, or disks, which provides a searchable audio-visual library



of issues of NEWSWEEK magazine and CINEMANIA® CD-ROM which provides reviews and other information on newly released films. For time-sensitive, low-value updates, for example, the latest issue of Newsweek or last week's movie reviews, distribution in stored form, on physical media, is slow and the cost may exceed the value of the information in the product....Communication between remote computers, not directly interconnected by umbilical cable or a wired network, is enabled by a wide range of hardware devices and software drivers, utilities, applications and application modules. ...General-purpose, online, modem-accessed, electronic information services, such as PRODIGY, COMPUSEVE and AMERICA ONLINE (trademarks), and some Internet services, provide wide access to timely information products from a central server, but are limited and complex. They provide no means for the integration of downloaded information with information products offered on disk or CD, and provide only rudimentary facilities for local viewing and search of downloaded files," pgs. 1-3, lines 1-14.

AAPA clearly discloses more than one independently published portable storage media (NEWSWEEK® Interactive CD-ROM and CINEMANIA® CD-ROM; PRODIGY, COMPUSEVE and AMERICA ONLINE) are stored on portable storage media such as diskette or CD. Specifically, one of ordinary skill would readily recognized that it is well known in the art the internet service providers PRODIGY, COMPUSEVE and AMERICA ONLINE, application programs and transport task that would be stored on a diskette or CD that via user intervention is obviously installed on a user station.

It would have been obvious to one of ordinary skill at the time the invention was made that implement into Filepp's system that includes diskettes (426 , 428) that provide access to related remote information content from one or more remote

information content sources with AAPA disclosure of a plurality of independently published portable storage media each storing a separate interface service provider wherein each includes a different application program and obviously predefined transport tasks thereby providing a user access to related remote information content because doing so would add and expand the flexibility of Filepp's system without departing from the inventive concept of Filepp.

Applicant also argues that "complete contrast to information content. The "programmed logic" of claim 140, when executed by a processor, enables "access at the user station to access, via the user interface, to fixed information content from each of a plurality of independently published portable storage media together with related remote information content from one or more remote information content sources" (emphasis added). Application software, such as reception system software stored on diskettes 426 and operating system software stored on diskettes 428, does not, in any way represent information content". Filepp teaches "programmed logic" from diskettes 426, and 428 that is stored on a hard-disk drive 420 and is the reason that computer 405 is able to interact with the interactive network, 10. The definition of "information content" is not defined by the claim in such a way that will not further distinguish the claim invention in terms of patentability, i.e. there is no clear definition of what is meant by information content. Examiner believes Filepp in view of AAPA teaches the user access to news, industry, financial needs, hobbies, and cultural interests, etc. by the plurality of internet service providers stored on independently published portable storage media.

As per claims 142-145, 150, 180, and 183, Filepp teaches wherein the user station connects to an interactive network 10, however, Filepp specifically teaches wherein "multiple servers, gateways and information layers.." could be included "in the event even larger numbers of users were sought to be served," col. 4, lines 19-43) In other words, Filepp's system is not limited to interaction with one remote source but could be connected to multiple servers for interaction with a host of other services. Therein, it would have been obvious to one of ordinary skill at the time the invention was made that Filepp's teaches another embodiment that does not limit the user station to interaction with just one remote source but with a system that could includes shared servers, gateways, etc. that would come from different remote sources. Further, it would have been obvious to one of ordinary skill in the art at the time of invention that because the software product takes the object-oriented approach, this ensures that user interface with be customized with the respective remote source content.

### **Conclusion**

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

The examiner requests, in response to this office action, support be shown for language added to any original claims on amendment and any new claims. That is, indicate support for newly added claim language by specifically pointing to page(s) and line number(s) in the specification and/or drawing figure(s). This will assist the examiner in prosecuting the application. When responding to this office action, applicant is advised to clearly point out the patentable novelty which he or she thinks the claims present, in view of the state of art disclosed by the references cited or the objections made. He or she must also show how the amendments avoid such references or objections. See 37 C.F.R.I .III(c).

In amending in reply to a rejection of claims in an application or patent under reexamination, the applicant or patent owner must clearly point out the patentable novelty which he or she thinks the claims present in view the state of the art disclosed by the references cited or the objections made. The applicant or

patent owner must also show how the amendments avoid such references or objections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tammara Peyton whose telephone number is (571) 272-4157. The examiner can normally be reached between 6:30 - 4:00 from Monday to Thursday, (I am off every first Friday), and 6:30-3:00 every second Friday. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on (571) 272- 6729. The fax phone number for the organization where this application or proceeding is assigned is (571) 273-8300. Any inquiry of a general nature of relating to the status of this application should be directed to the

Group receptionist whose telephone number is (571) 272- 2100.

/Tammara R Peyton/

Primary Examiner, Art Unit 2182

November 10, 2008